

- 1 -

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Childs et al.	:	Peugh, Brian R.
	:	
Serial No.: 10/618,213	:	Group Art Unit: 2187
	:	
Filing Date: July 11, 2003	:	
	:	Lenovo (United States) Inc.
Title: AUTONOMIC	:	Building 675
NON-INVASIVE BACKUP AND	:	4401 Silicon Drive
STORAGE APPLIANCE	:	Durham, NC 27709

SECOND APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. REAL PARTY IN INTEREST

At the time of the filing of the above-identified application, International Business Machines Corporation was the assignee of the entire right, title and interest in the above-identified patent application. International Business Machines Corporation has undergone negotiations with Lenovo (Singapore) Pte. Ltd. to transfer some of its intellectual property to them, including assigning the above-identified patent application to Lenovo (Singapore) Pte. Ltd.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-7 are pending in the Application. Claims 8-31 were pending in the Application but were cancelled. Claims 1-7 stand rejected. Claims 1-7 are appealed.

IV. STATUS OF AMENDMENTS

Appellants have not submitted any amendments following receipt of the final rejection with a mailing date of May 8, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1:

In one embodiment of the present invention, a backup system for a computer having a hard drive comprises a program appliance comprising a program attachable in data communication with the computer. Specification, page 5, line 23 – page 7, line 9; Figure 2, elements 203, 207. The backup system may further comprise a data storage appliance attachable in data communication with the computer, where the program is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive. Specification, page 5, line 23 – page 7, line 9; Figure 2, elements 203, 205, 207.

VI. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-7 stand rejected under 35 U.S.C. under 35 U.S.C. §102(b) as being anticipated by Symantec Corporation (Norton Ghost User's Guide) (hereinafter "Symantec").

VII. ARGUMENT

The Examiner has rejected claims 1-7 as being anticipated by Symantec. Office Action (10/27/2006), page 2. Appellants respectfully traverse these rejections for at least the reasons stated below.

A. Claim 1 is not anticipated by Symantec.

Appellants respectfully assert that Symantec does not disclose “a program appliance comprising a program attachable in data communication with the computer” as recited in claim 1. The Examiner cites pages 11 and 16-17 of Symantec as disclosing the above-cited claim limitation. Office Action (10/27/2006), page 3. Applicants respectfully traverse and assert that Symantec instead discloses that the Ghost Boot Wizard creates boot disks that start Norton Ghost when you turn on your computer. Page 11. Symantec further discloses the processes for creating boot images and disks. Page 16. Symantec additionally discloses the steps in creating a standard boot disk. Page 17. Hence, Symantec discloses creating boot disks¹.

There is no language in the cited passages that discloses a program appliance. The cited passages instead disclose a boot disk which is not a program appliance. Neither is there any language in the cited passages that discloses a program appliance that includes a program attachable in data communication with a computer. Thus, Symantec does not disclose all of the limitations of claim 1, and thus Symantec does not anticipate claim 1. M.P.E.P. §2131.

Appellants further assert that Symantec does not disclose “a data storage appliance attachable in data communication with the computer” as recited in claim 1. The Examiner cites the element of a CD-ROM as well as pages 10 and 19 of Symantec as disclosing the above-cited claim limitation. Office Action (10/27/2006), page 3. Appellants respectfully traverse and assert that Symantec instead discloses that Norton Ghost creates a copy of your hard disk before upgrading to another one. Page 10. Symantec further discloses that boot disks with CD-ROM support let you access images stored on the CD-ROM. Page 19. There is no language in the cited passages that discloses a data storage appliance attachable in data communication

¹ A boot disk may refer to a disk that contains the operating system ready to load into the computer. See <http://www.techweb.com/encyclopedia/defineterm.jhtml?term=bootabledisk>.

with the computer. Thus, Symantec does not disclose all of the limitations of claim 1, and thus Symantec does not anticipate claim 1. M.P.E.P. §2131.

Appellants further assert that Symantec does not disclose “wherein the program is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive” as recited in claim 1. The Examiner cites pages 11, 26-30 and 126² of Symantec as disclosing the above-cited claim limitation. Office Action (10/27/2006), page 3. Appellants respectfully traverse.

Symantec instead discloses that the Ghost Boot Wizard creates boot disks that start Norton Ghost when you turn on your computer. Page 11. Symantec further discloses finding the Norton Ghost license number. Page 26. Symantec additionally discloses navigating without a mouse. Page 27. Furthermore, Symantec discloses copying the contents of one hard disk onto another. Pages 28-29. Additionally, Symantec discloses copying an image file to another disk. Page 30.

There is no language in the cited passages that discloses a program of the program appliance that is configured to copy the files from the hard drive to the data storage appliance. Neither is there any language in the cited passages that discloses a program of the program appliance that is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive. Thus, Symantec does not disclose all of the limitations of claim 1, and thus Symantec does not anticipate claim 1. M.P.E.P. §2131.

As understood by Appellants, the Examiner had previously cited to a boot disk as disclosing a program appliance. Office Action (10/27/2006), page 3. There is no language in the cited passages that discloses a program of the boot disk configured to copy the files from the hard drive to the data storage appliance. Neither is there any

² The Examiner cites to page 126 of Symantec; however, this page was not provided to Appellants. Further, Appellants do not believe that the reference Symantec includes 126 pages.

language in the cited passages that discloses a program of the boot disk configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive.

Further, as understood by Appellants, the Examiner asserts that Norton Ghost software is not installed on the hard drive of the computer but is instead installed on the boot disk. Office Action (10/27/2006), page 3. Appellants respectfully traverse. The Examiner has not provided any basis for such an interpretation. Norton Ghost software is in fact installed on the hard drive of the computer. See pages 13-14 of Symantec dealing with installing Norton Ghost onto the hard drive of the computer.

Thus, Symantec does not disclose all of the limitations of claim 1, and thus Symantec does not anticipate claim 1. M.P.E.P. §2131.

B. Claims 2-7 are not anticipated by Symantec for at least the reasons that claim 1 is not anticipated by Symantec.

Claims 2-7 each recite combinations of features of independent claim 1, and thus claims 2-7 are not anticipated by Symantec for at least the reasons that claim 1 is not anticipated by Symantec.

C. Claim 2 is not anticipated by Symantec.

Appellants respectfully assert that Symantec does not disclose “wherein the program appliance and the data storage appliance are the same appliance” as recited in claim 2. The Examiner states:

Regarding claim 2, Symantec teaches wherein the program appliance and the data storage appliance are the same appliance [Consider a computer with two hard drives, the first containing the data to be backed up, while the second contains two partitions where the first partition comprises the ghost executable (page 11) and the second partition is empty. The second hard drive is interpreted as both the program appliance and the data storage appliance. The executable is executed from the first partition of the second drive, the source is

selected to be the first hard drive, and the destination location for the backup files is selected to be that of the second partition of the second drive [page 28-30]. Thus, Symantec teaches the claim limitations as recited. Neither appliance is claimed to be prohibited from being located with the computer. Also, one of ordinary skill in the art would recognize that the second hard drive could be located in an external enclosure connected to the computer via a USB network, and that the ghost executable could be booted from the external hard drive]. Office Action (10/27/2006), page 3.

Appellants respectfully traverse.

There is no language in the cited passages (pages 11 and 28-30 of Symantec) that support the Examiner interpretations of a computer having two hard drives, where the first hard drive contains data to be backed up and the second contains two partitions. Neither is there any language in the cited passages of Symantec that supports the other assertions by the Examiner. The Examiner is simply transmogrifying Symantec in order to provide a basis for the rejection. This is improper. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that Symantec discloses these assertions. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that Symantec discloses these assertions, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of anticipation for rejecting claim 2. M.P.E.P. §2131.

Symantec instead discloses a Ghost Boot Wizard that creates boot disks that start Norton Ghost when you turn on your computer. Page 11. Symantec further discloses that the Norton Ghost executable can be run from a DOS boot disk or hard drive. Page 11. Symantec further discloses the steps in cloning disk to disk and in cloning a disk to an image file. Pages 28-30. Hence, Symantec discloses having an

executable (a program file) run from a boot disk or hard drive. Symantec further discloses cloning disk to disk and cloning a disk to an image file.

There is no language in the cited passages that discloses having the program appliance and the data storage appliance being the same appliance. If the Examiner is asserting that the ghost executable (a program file) running from a boot disk or hard drive constitutes a program appliance, Appellants respectfully traverse. The ghost executable is not a program appliance. Neither is the ghost executable configured to copy the files from the hard drive of the computer to the data storage appliance without installation of the program on the hard drive. As mentioned above, claim 1 recites that the program appliance includes a program configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive.

Therefore, Symantec does not disclose all of the limitations of claim 2, and thus Symantec does not anticipate claim 2. M.P.E.P. §2131.

D. Claim 3 is not anticipated by Symantec.

Appellants respectfully assert that Symantec does not disclose “wherein the program is further configured to execute automatically upon the program appliance being attached to the computer” as recited in claim 3. The Examiner cites page 26 of Symantec as disclosing the above-cited claim limitation. Office Action (10/27/2006), page 4. Appellants respectfully traverse and assert that Symantec instead discloses finding the license number for Norton Ghost. Page 26. There is no language in the cited passage that discloses that the program is further configured to execute automatically upon the program appliance being attached to the computer. Thus, Symantec does not disclose all of the limitations of claim 3, and thus Symantec does not anticipate claim 3. M.P.E.P. §2131.

Further, in connection with the rejection of the above-cited claim limitation, the Examiner appears to assert that the ghost executable (a program file) of Symantec,

based on paragraph [0033] of Appellants' Specification discloses the above-cited claim limitation. Office Action (10/27/2006), page 4. Appellants respectfully traverse. As stated above, the ghost executable does not disclose the program appliance or a program of the program appliance. Neither is there any language in the cited passages that discloses that ghost executable executes automatically upon the program appliance being attached to the computer. Thus, Symantec does not disclose all of the limitations of claim 3, and thus Symantec does not anticipate claim 3. M.P.E.P. §2131.

Further, there is no language in paragraph [0033] of Appellants' Specification that would support the Examiner's interpretation. The Examiner is transmogrifying Appellants' Specification in order to provide a basis for the rejection. This is improper. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that the ghost executable of Symantec discloses a program of the program appliance that executes automatically upon the program appliance being attached to the computer. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that the ghost executable of Symantec discloses a program of the program appliance that executes automatically upon the program appliance being attached to the computer, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of anticipation for rejecting claim 3. M.P.E.P. §2131.

Further, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000); M.P.E.P. §2111. The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. §2111. Since the Examiner has not provided a reasonable interpretation consistent with the specification or consistent with the

interpretation that those skilled in the art would reach, the Examiner has not presented a *prima facie* case of anticipation for rejecting claim 3. M.P.E.P. §2111.

E. Claim 4 is not anticipated by Symantec.

Appellants respectfully assert that Symantec does not disclose “wherein the program is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive” as recited in claim 4. The Examiner cites pages 31-32, 36 and 39 of Symantec as disclosing the above-cited claim limitation. Office Action (10/27/2006), page 4. Appellants respectfully traverse.

Symantec instead discloses the steps involved in cloning a disk from an image file. Pages 31-32. Symantec further discloses cloning a partition from an image file. Page 36. Symantec additionally discloses adding switches to your cloning task. Page 39.

There is no language in the cited passages that discloses that the program is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive. Thus, Symantec does not disclose all of the limitations of claim 4, and thus Symantec does not anticipate claim 4. M.P.E.P. §2131.

F. Claim 5 is not anticipated by Symantec.

Appellants respectfully assert that Symantec does not disclose “a network in data communication with the computer; and a server computer in data communication with the network, wherein the data communication between the data storage appliance and the computer is provided through the server” as recited in claim 5. The Examiner cites pages 34, 42 and 99-101 of Symantec as disclosing the above-cited claim limitations. Office Action (10/27/2006), page 4. Appellants respectfully traverse.

Symantec instead discloses creating an image file from a partition to use as a backup, or to clone onto another partition. Page 34. Symantec further discloses that the image files created in Norton Ghost support several levels of data compression. Page 42. Symantec additionally discloses that peer-to-peer connections enable Norton Ghost to run on two computers, transferring drives and partitions and using image files between them. Page 99.

There is no language in the cited passages that discloses a network in data communication with the computer. Neither is there any language in the cited passages that discloses a server computer in data communication with the network. Neither is there any language in the cited passages that discloses that the data communication between the data storage appliance and the computer is provided through the server. Thus, Symantec does not disclose all of the limitations of claim 5, and thus Symantec does not anticipate claim 5. M.P.E.P. §2131.

G. Claim 6 is not anticipated by Symantec.

Appellants respectfully assert that Symantec does not disclose “wherein the program is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive” as recited in claim 6. The Examiner cites pages 31-32, 36 and 39 of Symantec as disclosing the above-cited claim limitation. Office Action (10/27/2006), page 4. Appellants respectfully traverse.

Symantec instead discloses the steps involved in cloning a disk from an image file. Pages 31-32. Symantec further discloses cloning a partition from an image file. Page 36. Symantec additionally discloses adding switches to your cloning task. Page 39.

There is no language in the cited passages that discloses that the program is further configured to copy the files from the data storage appliance to the hard drive

without installation of the program on the hard drive. Thus, Symantec does not disclose all of the limitations of claim 6, and thus Symantec does not anticipate claim 6. M.P.E.P. §2131.

H. Claim 7 is not anticipated by Symantec.

Appellants respectfully assert that Symantec does not disclose “wherein the program is further configured to execute automatically upon the program appliance being attached to the computer” as recited in claim 7. The Examiner cites page 26 of Symantec as disclosing the above-cited claim limitation. Office Action (10/27/2006), page 5. Appellants respectfully traverse and assert that Symantec instead discloses finding the license number for Norton Ghost. Page 26. There is no language in the cited passage that discloses that the program is further configured to execute automatically upon the program appliance being attached to the computer. Thus, Symantec does not disclose all of the limitations of claim 7, and thus Symantec does not anticipate claim 7. M.P.E.P. §2131.

Further, in connection with the rejection of the above-cited claim limitation, the Examiner appears to assert that the ghost executable (a program file) of Symantec, based on paragraph [0033] of Appellants’ Specification discloses the above-cited claim limitation. Office Action (10/27/2006), page 5. Appellants respectfully traverse. As stated above, the ghost executable does not disclose the program appliance or a program of the program appliance. Neither is there any language in the cited passages that discloses that ghost executable executes automatically upon the program appliance being attached to the computer. Thus, Symantec does not disclose all of the limitations of claim 7, and thus Symantec does not anticipate claim 7. M.P.E.P. §2131.

Further, there is no language in paragraph [0033] of Appellants’ Specification that would support the Examiner’s interpretation. The Examiner is transmogrifying Appellants’ Specification in order to provide a basis for the rejection. This is

improper. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that the ghost executable of Symantec discloses a program of the program appliance that executes automatically upon the program appliance being attached to the computer. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that the ghost executable of Symantec discloses a program of the program appliance that executes automatically upon the program appliance being attached to the computer, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of anticipation for rejecting claim 7. M.P.E.P. §2131.

Further, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000); M.P.E.P. §2111. The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. §2111. Since the Examiner has not provided a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach, the Examiner has not presented a *prima facie* case of anticipation for rejecting claim 7. M.P.E.P. §2111.

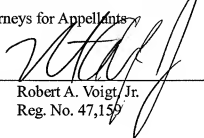
VIII. CONCLUSION

For the reasons noted above, the rejections of claims 1-7 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-7.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellants

By: 
Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

CLAIMS APPENDIX

1. A backup system for a computer having a hard drive comprising:
a program appliance comprising a program attachable in data communication with the computer; and
a data storage appliance attachable in data communication with the computer, wherein the program is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive.
2. The backup system of claim 1 wherein the program appliance and the data storage appliance are the same appliance.
3. The backup system of claim 1 wherein the program is further configured to execute automatically upon the program appliance being attached to the computer.
4. The backup system of claim 1 wherein the program is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive.
5. The backup system of claim 1 further comprising:
a network in data communication with the computer; and
a server computer in data communication with the network, wherein the data communication between the data storage appliance and the computer is provided through the server.
6. The backup system of claim 5 wherein the program is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive.

7. The backup system of claim 5 wherein the program is further configured to execute automatically upon the program appliance being attached to the computer.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to the current proceeding.